

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Daniel A. Lidar et al.
Patent No. : 7,364,923
Issued : April 29, 2008
For : DRESSED QUBITS

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FEB 06 2012

Examiner : Stephen W. Smoot OFFICE OF PETITIONS
Art Unit : 2813
Docket No. : 240105.438
Date : JANUARY 27, 2012

Mail Stop: PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NOTIFICATION OF LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS UNDER
37 C.F.R. 1.27(G)

Commissioner for Patents:

The Governing Council of the University of Toronto (hereinafter University of Toronto), dba The University of Toronto, is the assignee of the entire right, title, and interest in the entirety of U.S. Patent 7,364,923 (hereinafter the '923 Patent) which granted from U.S. patent application Serial No. 10/788,546. University of Toronto owns all right, title and interest to the '923 Patent.

University of Toronto qualified to pay fees for U.S. patent application Serial No. 10/788,546 as a small entity. As a result of the University of Toronto's licensee losing its entitlement to claim small entity status, University of Toronto no longer qualifies to pay fees for the '923 Patent as a small entity.

Patent No. 7,364,923

University of Toronto made a bona fide good faith attempt to change entity status and pay the maintenance fee on September 20, 2011. On November 1, 2011, another attempt was made on the behalf of University of Toronto to pay the maintenance fee at the large entity rate. As indicated in the Notice Mailed December 8, 2011, that attempt was considered ineffective as not signed in accordance with 37 C.F.R. 1.33(b). Notably, the fee was taken from the deposit account indicated in the transmittal. A further attempt was made on November 30, 2011, to pay on the University of Toronto behalf the 1) difference in fee resulting from a fee increase which occurred between the first attempt and the second attempt, as well as 2) a surcharge charge for the maintenance fee being considered late. Notably, those fees were taken from the deposit account indicated in the transmittal.

University of Toronto provides a Statement under 37 C.F.R. 3.73(b) herewith, establishing that it is the assignee of the entire right, title, and interest in the entirety of the '923 Patent, and holds all right, title and interest in the '923 Patent.

This written assertion of loss of entitlement to pay fees as a small entity is executed by an authorized officer of University of Toronto.

In response to University of Toronto's attempt to pay the maintenance fee at the correct large entity rate, the U.S. Patent Office accepted fees calculated at small entity rate as well as an additional payment to make up for the deficiency. Thus, University of Toronto provides the following itemization, in compliance with 37 C.F.R. 1.28(c).

FEE TYPE	CURRENT AMOUNT AT NON-SMALL ENTITY RATE	AMOUNT PAID AT SMALL ENTITY RATE	DATE PAID	DEFICIENCY
4 th year Maintenance Fee	\$1,130	\$490 \$490 (total \$980)	September 20, 2011 November 1, 2011	\$150
4 th Year Maintenance Fee – Surcharge	\$150	\$150	November 30, 2011	\$0
DEFICIENCY PAYMENT				
4 th year Maintenance Fee Deficiency	\$150	\$150	November 30, 2011	\$0

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As such, University of Toronto believes the record clearly demonstrates that the payments on September 20, 2011 and October 27, 2011 of the 4th year maintenance fee in the '923 Patent at small entity rate was through error, despite University of Toronto's bona fide attempt to provide notice of the loss of small entity status, and thus compliance the requirements of 37 C.F.R. 1.28(c) have been met.

Additionally, University of Toronto believes that the USPTO's acceptance of a \$300 payment made on November 30, 2011 now completes the payment due as a result of the change of entity status, including fees due to change in the fee amount and surcharge and respectfully requests that the Notice Mailed December 8, 2011 be reconsidered and that University of Toronto's assertion of loss of entitlement to pay fees as a small entity be accepted.

The Governing Council of the University of Toronto

By: C. S. Gibbons

Cyril S. Gibbons, Ph.D. as Director, Business
Development and Commercialization Physical
Sciences and Engineering

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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Daniel A. Lidar et al.
 Application No./Patent No.: 7,364,923 Filed/Issue Date: April 29, 2008
 Entitled: DRESSED QUBITS

The Governing Council of the University
of Toronto

(Name of Assignee)

university

(Type of Assignee, e.g., corporation, partnership,
university, government agency, etc.)

states that it is:

- the assignee of the entire right, title, and interest in;
- an assignee of less than the entire right, title and interest in
(The extent (by percentage) of its ownership interest is _____ %); or
- the assignee of an undivided right, title and interest in the entirety of (a complete
assignment from one or more of the joint inventors was made)

the patent application/patent identified above by virtue of either:

- A. An assignment from the inventor(s) of the patent application/patent identified above.
The assignment was recorded in the United States Patent and Trademark Office at
Reel D18436, Frame 0380, or for which a copy thereof is attached.

OR

- B. A chain of title from the inventor(s), of the patent application/patent identified above, to the
current assignee as follows:

1. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____

The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached. Additional documents in the chain of title are listed on a supplemental sheet(s).

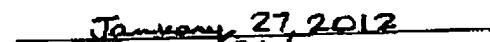
- As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the
original owner to the assignee was, or concurrently is being, submitted for recordation
pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment
Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP
302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.



Signature



Date

Director, Business Development and
Commercialization Physical
Sciences and Engineering

Title

Cyril S. Gibbons, Ph.D.

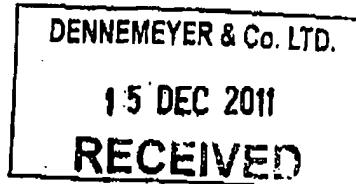
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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE WA 98104



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 DEC 08 2011
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In re Patent No: 7,364,923
 Issued: April 29, 2008
 Application No. 10/788,546
 Filed: February 27, 2004
 Attorney Docket No. 240105.438

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 NOTICE FEB 06 2012
 OFFICE OF PETITIONS

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed November 1, 2011.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby DISMISSED.

The request under 37 CFR 1.28 cannot be accepted at this time since it appears that the petition is not signed by a person having authority to act in the above-identified patent.

Petitioner's attention is directed to 37 CFR 1.33(b), which states.

Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

- (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
- (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
- (3) An assignee as provided for under § 3.71(b) of this chapter; or

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(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

Further, that part of the request that is directed to the maintenance fee deficiency payment is not signed by the proper party. A.J. Peach is not authorized to sign the request. Accordingly, the request cannot be accepted until it is signed by all inventors, an attorney or agent registered to practice before the U.S. Patent and Trademark Office or the assignee of the entire interest under 37 CFR 3.73(b).

Additionally, the current large entity three and a half year maintenance fee is \$1,130.00. Petitioner has submitted \$490.00 towards the required \$640.00 deficiency fee payment, thus creating a \$150.00 shortage.

Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Additionally, the address given on the request differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

cc: A J PEACH
DENNEMEYER & CO LTD
REGENT HOUSE HEATON LANE
STOCKPORT CHESHIRE
ENGLAND SK4 1BB

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Deposit Account Statement



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Finance
Online
Shopping
Cart

Deposit Account Statement**Requested Statement Month:****Deposit Account Number:****Name:****Attention:****Street Address 1:****Street Address 2:****City:****State:****Zip:****Country:**

DATE SEQ	REF	POSTING TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT
11/01 26		7364923		1599	\$490.00